UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/686,908	12/27/84	LEMELSON J	

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EXAMINER	
SHAW, C	
ART UNIT	PAPER NUMBER
213	5

DATE MAILED: 02/24/86

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 12/2/85 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1-7, 11-13, 15, & 18-20 are allowed.
4. ☒ Claims 8-10, 14, 16, & 17 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☒ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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PTOL-326 (Rev. 7-82) EXAMINER'S ACTION

1. The specification is objected to. On page 1 of the specification, applicant refers to the instant case as a C-I-P of serial no. 225,173 having parent application S.N. 515,147. In paper no. 18 of parent case S.N. 05/968,216 it was decided that the instant case was not a CIP of S.N. 225,173. Applicant is to delete the references to serial no. 225,173 and 515,147 on page 1 of the specification.

2. The substitute oath filed 12/6/1985 is objected for refering to the instant case as a C-I-P of 225,173. To overcome this objection, applicnat should file a substitute oath, labeled as such, setting forth the correct parent cases of the instant case.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless-
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

4. Claims 8, 9, 10, and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Fraser. Fraser discloses the subject matter claimed. In regard to claim 14, note that the dye coated case taught by Fraser constitutes the claimed "recording mateiral. . .secured to one side of said sheet-like record member". Applicant is to note that the claim limitations specifying that the recording member is a "rectangular wall" (claim 8), a "sheet of thin, elongated rectangular recording material" (claims 9 and 10), and a "flat

sheet-like member" (claim 14) preclude applicant from relying on S.N. 225,173 for a prior date. Applicant is to note that in the decision of the Board of Appeals in the parent case (paper no. 26 of case S.N. 05/968,216), the Board stated on page 6 ". . .we do not feel that the recording member 100 in application Serial No. 225,173 can fairly be described as being 'in the form of a flat sheet material'."

5. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 16 and 17 are rejected under 35 U.S.C. 103 as being unpatentable over Lee, Jr. et al. Lee, Jr. discloses subject matter claimed, including memeory 11. The claims differ in calling for applying a control signal to address a memory after the object to be recorded on is positioned. This difference does not patentably distinguish over Lee, Jr. It is considered obvious that the control signal for memory 11 of Lee,

Jr. not be applied until the recording ~~tape~~ tape is positioned for recording, thereby satisfying the claims.

7. Claims 1-7, 11-13, 15, 18-20 allowable over the prior art of record.

8. Applicant's arguments filed 12/2/1985 have been fully considered but they are not deemed to be persuasive. Applicant's amendments to claims 8-10, 16, 17, and 20 overcome the rejections based on the first paragraph of 35USC112 in the first Office action. Applicant's arguments concerning the C-I-P status of the instant case are not persuasive. The Board of Appeals never held that the instant case is a C-I-P of S.N. 225,173. Paper no. 18 in parent case S.N. 05/968,216 clearly states that the instant case is not a C-I-P of S.N. 225,173. The rejected claims do not distinguish over the prior art as discussed above.

9. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT

WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Shaw/dc

703/557/4856

2/18/86

CLIFFORD C. SHAW
PRIMARY EXAMINER
ART UNIT 213